REMARKS

Claims 1, 3 and 5 have been rejected under 35 USC 103(a) as unpatentable over Morse (U.S. Patent No. 3,588,440). This rejection is respectfully traversed.

The claimed invention is directed to a method of manufacturing an optical head by which a minute opening can be formed in an accurate position of an exit surface of the element such that near-field light is emitted with reliability. For this purpose, the minute opening is formed on the exit surface of a near-field light generating element. The optical head (e.g. the near-field light generating element fixed on a holding member) is disposed in a place where the optical head is used for recording and/or reproduction. Additionally, the opening is formed by the light from a first light source, which is used for recording and/or reproduction, or the second light source disposed in a position conjugated with the first light source.

Morse, on the other hand, has two laser light sources, and combines lights from lasers for focusing on a workpiece. One laser light source melts a spot on the workpiece, and the other source maintains the liquid spot. A positioning and feeding table is employed to locate the spot on the workpiece at which the combination of the lasers is active. That is, in Morse, a condenser lens 22 and workpiece are distinct, and the workpiece processed is used regardless of Morse's system. Whereas, in the claimed invention, the near-field light generating element which is to be processed and the light condensing element are integral. (See, for example, claim 1 required the near-field light generating element is fixed to a holding member to form an optical head). Similarly, a light source for processing is also disposed in a position equivalent to the state where the optical head is used for recording and/or reproduction apparatus equipped with the optical head or an apparatus equivalent to it serves as the hole-processing machine. For example, claim 1 recites that the optical head is disposed in a place where the optical head is used for a recording and/or reproduction, and the first light source is disposed in a prescribed position where the first light source is used for the recording and/or reproduction. Morse also discloses a precision positioning stage to make the opening in an exact position. However, even if the opening is formed in the exact position on the workpiece by using the

precision positioning stage, when mounting the opening into an optical head, it is necessary to adjust the opening to a condensing point of the optical head. This is exactly what is described in the background of the invention (i.e. prior art) of the instant application. The diameter of the opening for near-field light is equal to or less than the wavelength of the light. Hence, in order for the near-field light to leak from the opening, it is difficult to form the opening if the light source, focusing optical unit and the workpiece are not disposed in a use condition or equivalent of the use condition. Morse fails to use ultra precise processing and does not teach or suggest the manufacturing method of the claimed invention. The claimed invention, on the other hand requires forming an opening in the film by use of light emitted from at least one of two light sources, where the a first light source is disposed in a prescribed position where the first light source is used for the recording and/or reproduction, and the second light source is disposed in a position conjugate with the first light source.

Additionally, as stated by the Examiner, Morse fails to disclose the workpiece is a near-field light generating element having a film thereon. However, the Examiner says the reference could be easily modified to disclose same. However, the Examiner merely make a conclusory statement of obviousness without any evidentiary support on the record. The Examiner may not conclude, without evidentiary support, that one would have been motivated to combine the applied references without presenting a source of a teaching, suggestion or motivation to combine these references. This teaching, suggestion or motivation "must be articulated and placed on the record. The failure to do so is not consistent with...judicial review....conclusory statements [alone can not be used] when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies." *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (CAFC 2002). Applicants therefore request that the Examiner cite references in support of his finding of a motivation to combine the prior art disclosures.

Since the recited method is not disclosed by the applied prior art, claim 1 is patentable. Claims 3-5, depending from claim 1 (either directly or indirectly), are similarly patentable.

Claims 2, 3 and 16-19 have been rejected under 35 USC 103(a) as unpatentable over Morse. The rejection is respectfully traversed for the same reasons presented above in the arguments with respect to claim 1. Hence, claims 16 and 19 are patentable. Claims 2-3 and 17, depending from claims 1 and 16, respectively, are similarly patentable.

Claims 7-15 have been indicated by the Examiner as allowable if rewritten in independent form to include any base and intervening claims. In view of the forgoing arguments, applicants do not believe it is necessary to rewrite claims 7-15 at this time.

In view of the above, early action allowing this application is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 325772022100.

Dated: August 12, 2003

Respectfully submitted,

By _____

Barry E. Bretschneider
Registration No. 28,055
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
Phone (703) 760-7743
Facsimile (703) 760-7777